

REMARKS

Claims 1-9, 11-14, 16-31, and 33-51 were pending as of the action mailed on August 4, 2008. Claims 1, 9, 13, 30, 38, 42, and 50 are in independent form.

The examiner rejected claims 1-7, 9-10, 12-14, 16, 17, 19, 23, 24, 26-28, 30, 31, 33-36, 38-39, 41-46, 48, and 50 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0010746 ("Jilk") in view of S. Dusse et. al., *S/MIME Version 2 Message Specification*, THE INTERNET ENGINEERING TASK FORCE REQUEST FOR COMMENTS: 2311, March 1998, <http://www.ietf.org/rfc/rfc2311.txt> ("Dusse") in view of U.S. Patent No. 6,078,951 ("Pashupathy"). The examiner rejected claims 8, 11, 18, 20, 29, 37, 40, 47, 49, and 51 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jilk in view of Dusse in view of Pashupathy in view of ADOBE SYS. INC., *PDF REFERENCE* (2d ed. 2000), <http://www.adobe.com/devnet/pdf/pdfs/PDFReference13.pdf> ("PDF Reference").

While the examiner stated that all pending claims were rejected, the applicant notes that the examiner identified claim 10 as being rejected (*see* Office Action p. 2). Claim 10 was previously canceled in the applicant's "Amendment in Reply to Action Mailed April 10, 2007, Filed with Request for Continued Examination." The examiner also stated in the office action summary that claims 21-22 and 25 were also pending and rejected in this application. Claims 21-22 were canceled in the applicant's "Amendment in Reply to Action Mailed March 22, 2006." Claim 25 was canceled in the applicant's "Amendment in Reply to Action Mailed April 10, 2007, Filed with Request for Continued Examination." The applicant respectfully requests that such claims not be considered at this time, though the applicant reserves the right to present such claims at a later time.

Section 103 Rejections

Claim 1 was rejected as being unpatentable over Jilk in view of Dusse in view of Pashupathy. Claim 1 recites using a second application on the client distinct from the first application to transmit the first container object to a recipient's address, wherein the second application is an e-mail client application or a Web browser application. The examiner states

that Jilk discloses the claimed second application at Figures 3A and 3B and paragraph 0096, lines 9-30, and paragraph 0097. Specifically, the examiner states that:

The system of Jilk provides for sending the container via email, the use of email dictates that the email program produces the container (email) and then passes the composed message with the certificates to an OS module such as WinSock which formats the message according to network protocols and sends the message" (see Office Action at p. 4).

The applicant respectfully disagrees.

Paragraph 0096 of Jilk reads as follows:

Referring now to FIG. 3A, a method 300 for operating a Web server through electronic mail, according to an embodiment of the present invention, includes: transmitting a URL request or form data via email (step 303); retrieving the request email (step 305); preprocessing the email (step 307), for example by interpreting the URL request or form data, retrieving the Web page according to the request email (step 309); transcoding the resulting Web page (step 311); and transmitting the Web page via email (step 313). The term transcoding refers to translating a Web page from a first format--the format produced directly by the Web server and displayable on a Web browser client--to a second format that can be directly operable in the email environment in accordance with one or more aspects of this invention. As is commonly understood, an email environment includes 1) an emailer such as sendmail, an SMTP server, or some other mechanism for sending email, 2) one or more intermediate relay stations that may interpret and/or modify the email, e.g., to wrap words, or reformat the email, and 3) an email browser, also called email reader or email client, to read and display the email. Directly operable means that any of one or more of the links or form controls such as buttons and pulldown menus, is directly and automatically operable as though it were in a Web browser but using email as the transport mechanism, for example by clicking on the link or control, rather than by requiring any cutting or pasting or other manual operations. Interpreting includes any email-environment (e.g., email browser) specific translating and includes interpreting any specialized form tags and variables introduced by earlier transcoding in the case that the URL or form data is transmitted via email by a user as a result of receiving and operating a transcoded Web page.

Paragraph 0097 of Jilk reads as follows:

Referring now to FIG. 3B, a method 301 is shown. In step 306, a first Web page is sent to a first email address as a first email message. The first Web page includes one or more links or form controls that provide for further interaction by a user, and is in a format consistent with one or more properties of a first email

environment. That format is such that the first Web page is directly operable in an email client, for example an instance of an email browser of the first email environment. The method now proceeds with one or more steps of method 300. The user transmits a URL request or form data via email (step 303), e.g., in response to the user operating the received first Web page, and the method retrieves the request email (step 305). In one embodiment, the email is preprocessed (step 307), for example by interpreting the URL request or form data. A Web page is retrieved according to the request email (step 309). The resulting Web page is transcoded (step 311); and transmitted via email (step 313).

Specifically, the examiner points to a second application as an OS module of WinSock. However, neither this assertion nor the cited portions of Jilk disclose or suggest a second application that is an e-mail client application or a Web browser application, as required by claim 1.

Claim 1 specifically requires that the second application be an e-mail client application or a Web browser application. However, the examiner does not identify this feature as present in Jilk. Instead the examiner states that the first application, not the second application, is an e-mail application. Furthermore, the examiner has identified neither an e-mail application nor a Web browser application as the claimed second application. Consequently, the examiner fails to make a *prima facie* case for obviousness under Section 103.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [MPEP § 2142 (emphasis added)]

As set forth above, the examiner has failed to show that the actual claim limitations are taught or suggested by the references. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis

added). Therefore, the applicant respectfully submits that claim 1, as well as claims 2-8, which depend from claim 1, are in condition for allowance.

Claims 9, 13, 30, 38, 42, and 50 recite features corresponding to claim 1 and were rejected for the same reasons. Therefore, for the same reasons as set forth above with respect to claim 1, claims 9, 13, 30, 38, 42, and 50 are also in condition for allowance. Likewise, claims 11-12, which depend from claim 9, claims 14, 16-20, 23-24, and 26-29, which depend from claim 13, claims 31 and 33-37, which depend from claim 30, claims 39-41, which depend from claim 38, claims 43-49, which depend from claim 42, and claim 51, which depends from claim 50, are also in condition for allowance.

Furthermore, claim 1 also recites automatically obtaining a second container object from the second application, the second container object having been received by the second application and the second container object having the same recognizable container type as the first container object. The examiner states that Jilk discloses the claimed automatic obtaining of a second container object from the second application at paragraph 0097. The applicant respectfully disagrees.

Paragraph 0097 of Jilk is set forth above in its entirety. Specifically, the cited portion of Jilk discloses a user transmitting a URL request or form data via email. However, Jilk does not disclose or suggest automatically obtaining a second container object from the second application, as required by claim 1.

The applicant respectfully submits that claim 1, as well as claims 2-8, which depend from claim 1, are allowable for this additional reason.

Claims 9 and 13 recite features corresponding to claim 1 and were rejected for the same reasons. Therefore, for the reasons set forth above with respect to claim 1, claims 9 and 13 are also in condition for allowance. Likewise, claims 11-12, which depend from claim 9, and claims 14, 16-20, 23-24, and 26-29, which depend from claim 13, are also in condition for allowance.

Conclusion

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply any charges or any credits to deposit account 06-1050.

Respectfully submitted,

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